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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,986	02/09/2001	Michael Brumbaugh	10812/3	2253

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EXAMINER

COHEN, AMY R

ART UNIT PAPER NUMBER

2859

DATE MAILED: 05/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/780,986

Applicant(s)

BRUMBAUGH, MICHAEL

Examiner

Amy R Cohen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-23, drawn to a mounting tool, classified in class 33, subclass 613.
  - II. Claims 24-27, drawn to a method of mounting a position measuring device to a machine tool, classified in class 33, subclass 562.
2. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product such as one which does not have a height gauge.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Freeman on May 14, 2002 a provisional election was made with traverse to prosecute the invention of Group II, claims 24-47. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

*Drawings*

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show a corresponding opening 231, the upper leg 220 in Fig. 12, the details attributed to Fig. 12 on page 8, lines 7-29, central opening 242, reference numbers 202, 204, 206, 208, 230, 234, and 250 in Fig. 17 as disclosed in the specification, and reference numbers 206, 210, 234, 236A-C, 238A-C, 250, and the two situations where there is no extension guide in Fig. 18 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. Figures 1-11 contain subject matter, which is disclosed as prior art therefore each item should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings and the specification are objected to because it is unclear what the relationship is between 236A-C and 236R,L and the relationship between 238A-C and 238R,L. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 24-47 refer to a template while the specification on page 8 lines 9-10 refer to "--a template in the form of base 202--." It is unclear as to whether the base is the template or another template is described.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 recites the limitation "--detaching said template from said reading head prior to said attaching--" in a method of mounting a position measuring device to a machine tool. It is unclear as to which attaching this feature refers since earlier claims also include attaching of various parts of the apparatus.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 24-47 are rejected under 35 U.S.C. 102(b) as being anticipated by ACU-RITE (ENC 150 Encoder Mounting Instructions).

The date of publication of the ACU-RITE ENC 150 Encoder Mounting Instructions is unclear, however, the ACU-RITE ENC 150 Reference Manual Edition D is dated August 1998. Therefore, the date of the ENC 150 Encoder Mounting Instructions is taken to also be August 1998.

ACU-RITE teaches a method of mounting a position measuring device to a machine tool, comprising: positioning a template adjacent to said machine tool, wherein said template comprises a plurality of holes that correspond to mounting holes of a position measuring device and said template is distinct from said position measuring device; forming holes in said machine tool based on positions of said plurality of holes; aligning said mounting holes of said position measuring device with said holes formed in said machine tool; and attaching said position measuring device to said machine tool (Step "Encoder Installation," page 2).

ACU-RITE teaches the method of mounting a position measuring device wherein said position measuring device comprises a linear encoder and wherein attaching comprises inserting screws into said aligned mounting holes of said position measuring device and said holes formed in said machine (Step "Encoder Installation," page 3 and "Cross Feed Installation" figure, page 4).

ACU-RITE teaches the method of mounting wherein said template is not a linear encoder ("Cross Feed Installation" figure, page 4).

ACU-RITE teaches the method of mounting wherein said machine tool does not move along an axis of travel from the time of positioning to said time of attaching and wherein said template is supported on said machine tool during said positioning (Step "Encoder Installation," pages 2-3).

ACU-RITE teaches the method of mounting comprising attaching said position measuring device to a reading head bracket prior to said positioning and comprising positioning said reading head bracket against said machine tool; and marking mounting holes of said reading head bracket on the machine tool (Steps "Encoder Installation" and "Reading Head Installation," pages 2-3).

ACU-RITE teaches the method of mounting comprising detaching said position measuring device from said reading head bracket; and attaching said reading head bracket to said machine tool where said mounting holes are located and comprising attaching said template to said machine tool subsequent to said positioning of said template (Steps "Center Support Installation" and "Reading Head Installation," page 3).

ACU-RITE teaches the method of mounting comprising adjusting said template so as to be aligned with an axis of travel of said machine tool and comprising detaching said template from said reading head bracket prior to said attaching (Step "Reading Head Installation," page 3).

ACU-RITE teaches a method of mounting a position measuring device to a machine tool, comprising: positioning a template adjacent to said machine tool, wherein said template comprises a plurality of holes that correspond to mounting holes of a spar that is to support a position measuring device and said template is distinct from said position measuring device;

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forming holes in said machine tool based on positions of said plurality of holes; aligning said mounting holes of said spar with said holes formed in said machine tool; attaching said spar to said machine tool; and attaching said position measuring device to said spar (Steps "Cross Feed Installation" figure, page 4 and "Spar Assembly," page 5-6).

ACU-RITE teaches the method of mounting wherein said attaching of said spar comprises inserting screws into said aligned mounting holes of said position measuring device and said holes formed in said machine tool and wherein said machine tool does not move along an axis of travel from the time of positioning to said time of attaching said spar and comprising detaching said template from said reading head bracket prior to attaching of said spar (Step "Spar Assembly," pages 5-6).

9. Claims 24-47 are rejected under 35 U.S.C. 102(a) as being anticipated by ACU-RITE (ENC 150 Encoder Mounting Instructions).

If, for some reason, the date of the ACU-RITE (ENC 150 Encoder Mounting Instructions) reference is determined to be less than one year from the filing date of this application, then this reference qualifies as prior art under 102(a).

The rejection stated above in paragraph 8 is considered to be repeated here.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. ACU-RITE (ENC 150 Reference Manual, August 1998, Edition D), Ham (U. S. Patent No. 5,343,628), Horvallius (U. S. Patent No. 4,015,339), Sorton (U. S. Patent No. 4,947,616), Gibbons et al. (U. S. Patent No. 6,077,000), Meyer et al. (U. S. patent No.



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3,942,895), Ochiai et al. (U. S. Patent No. 6,119,357), Leonard (U. S. Patent No. 4,429,466), Pechak (U. S. Patent No. 4,936,023), Menk et al. (U. S. Patent No. 5,937,531), Schnetzler et al. (U. S. Patent No. 6,260,285), Kelly et al. (U. S. Patent No. 5,509,213) all refer to a method of mounting or use of a position measuring device and/or a template for mounting a device.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R Cohen whose telephone number is (703) 305-4972. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3431.

ARC  
May 15, 2002

  
Diego Gutierrez  
Supervisory Examiner  
Tech Center 2800